

R E M A R K S

Claims 1-20 stand as originally filed. Re-examination and reconsideration are requested.

5 In the office action, paper number 3, dated August 1, 2003, 2003, the examiner rejected claims 1-20 under 35 U.S.C. §102(e) as being anticipated by Akiba, et. al., U.S. Patent No. 6,559,967 (Akiba).

Legal Standard For Rejecting Claims Under 35 U.S.C. §102

10 The standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. §102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 90 (Fed. Cir. 1986).
15 Invalidity for anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. Scripps Clinic & Research Foundation v. Genentech, Inc., 18 USPQ2d 1001 (Fed. Cir. 1991). Furthermore, functional language, preambles, and language in "whereby," "thereby," and
20 "adapted to" clauses cannot be disregarded. Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871 (Fed. Cir. 1990).

Re the Rejections of Claims 1-20:

25 The examiner rejected claims 1-20 as being anticipated by Akiba. These rejections are improper in that Akiba fails to disclose each and every limitation contained in the pending claims.

The Akiba reference is directed to a multi-function digital copier of the type that may be used in a stand-alone mode to make photocopies or in a mailbox mode to print copies from electronic

files sent by a host computer to the copier mailbox. More specifically, the Akiba reference focuses on providing the copier with an improved mailbox function wherein the display device provided on the copier itself may be conveniently used to allow the user to change the printing mode previously selected by the host computer. By displaying the various printing modes on the display provided on the copier itself, a user at the control panel of the copier may review and/or change the printing mode previously selected by the host computer without the need for the user to remember the originally-selected printing mode. See, for example, Akiba at col. 1, lines 52-58. In addition, the Akiba reference contains a general description of the functions and operations of the copier when operated in either the stand alone mode or the mailbox mode.

Claim 1 of the present application is directed to image display orientation control apparatus that comprises a first setting and a second setting. The first setting causes an image of an object scanned by a scanner apparatus to be displayed in a first orientation. The second setting causes the image to be displayed in a second orientation. Claim 1 also requires that the first setting be "preserved for subsequent uses of the scanner apparatus until changed by a user." This limitation is not met by Akiba.

The examiner cites to two different portions of the Akiba disclosure to support his anticipation rejections. However, neither portion supports the proposition that Akiba anticipates claim 1. In the first portion cited by the examiner, contained at col 9, lines 46-50, Akiba discloses that the copier has setting keys 801 and 802 (Figure 8) that instruct the copier to print the copies for bound sheets in either a right/left opening or an up/down opening. Akiba then goes on to say that "[i]n this embodiment, the direction (orientation) of document (portrait or landscape) is defined as shown in FIG 9." While it is not clear whether the setting keys 801 and 802 change the direction (i.e., orientation) of the original document or whether they control the

orientation of the copies (i.e., right/left opening or up/down opening), what is clear is that Akiba makes no mention as to whether either setting is preserved for subsequent uses of the copier until changed by a user.

5 The language in the second portion of Akiba, i.e., that contained in col. 6, lines 57-64, also fails to support the proposition that Akiba anticipates claim 1. The second portion of Akiba states as follows:

10 "The image memory unit 405 is also used in a case in which, when transmitting an image read by the copier 100 to the host computer 1000 via the computer interface unit 403 (an image scanner function), image data from the image memory unit 3 is developed and converted into a data format suitable for transmission to the host computer 1000, and resultant data is transmitted from the computer interface unit 403."

15 This statement merely describes that the copier may be used in an image scanner function to send image data to the host computer. The statement says nothing about a document orientation setting, much less whether any setting is preserved for subsequent uses until changed by a user.

20 Because the Akiba reference fails to disclose at least one limitation of claim 1, i.e., that the first setting be "preserved for subsequent uses. . . until changed by a user," Akiba cannot anticipate claim 1 as a matter of law. Dependent claims 2-6 are at least allowable in that they depend from claim 1, which is allowable.

25 Independent claim 7 is allowable over Akiba in that claim 7 requires, at least, that each of the plurality of settings be "preserved for subsequent uses of said scanner apparatus until changed by a user." Again, Akiba makes no mention as to whether the document print settings (controlled by keys 801 and 802, Figure 8) or the portrait or landscape settings (Figure 9) are preserved for subsequent uses until changed by a user.

30 Therefore, Akiba cannot anticipate claim 7.

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Independent claim 8 is directed to scanner apparatus having a switch that allows a user to select between a first setting and a second setting to cause the image of the scanned object to be displayed in respective first and second orientations. Claim 8
5 also requires that the first setting be "preserved for subsequent uses of said scanner apparatus until changed by said user." Because at least this limitation of claim 8 is not met by Akiba, Akiba cannot anticipate claim 8. Therefore, claim 8, and the claims depending therefrom, i.e., claims 9-12, are allowable.

10 Independent claim 13 is directed to image display orientation control software comprising a first setting which causes an image of an object scanned by a scanner to be displayed in a first orientation and a second setting which causes an image of the object to be displayed in a second orientation. Claim 13
15 also requires that the first setting be "preserved for subsequent uses of said image display orientation control software until changed by a user." Because at least this limitation of claim 13 is not met by Akiba, Akiba cannot anticipate independent claim 13.

20 Independent claim 14 is directed to a scanning system that comprises image display orientation control apparatus that is operable in a first setting and a second setting, the first setting causing display apparatus to display the image of the object in a first orientation, the second setting causing the
25 display apparatus to display the image of the object in a second orientation. Independent claim 14 also requires that the first setting be "preserved for subsequent uses of said scanner apparatus when the first setting is selected by the user." Because at least this limitation is not disclosed by Akiba, Akiba
30 cannot anticipate independent claim 14. Dependent claims 15-17 are also allowable over Akiba at least because they depend from claim 14, which is allowable over Akiba.

Independent claim 18 is directed to image display orientation control apparatus that includes at least first means
35 for causing an image of an object scanned by the scanner

apparatus to be displayed in a first orientation and second means for causing the image to be displayed in a second orientation. Claim 18 also requires that the first means be "preserved for subsequent uses of said scanner apparatus until changed by a user." Akiba fails to disclose a device or system meeting this limitation. Therefore, Akiba cannot anticipate independent claim 18.

Independent claim 19 is directed to a method for controlling image display orientation of a scanner apparatus that comprises the step of "providing image display orientation control apparatus. . . operable in a first setting and a second setting. . . so that the first setting is preserved for subsequent uses of said scanner apparatus when the first setting is selected by a user. . . ." Because Akiba fails to disclose an image display orientation control apparatus having a first setting that is preserved for subsequent uses when the first setting is selected, Akiba cannot meet at least the cited limitation of independent claim 19. Therefore, independent claim 19 is not anticipated by Akiba.

Independent claim 20 is directed to a method for controlling image display orientation of scanner apparatus that comprises "selecting a first orientation or a second orientation, said first orientation being preserved for subsequent uses of said scanner apparatus until changed by a user. . . ." Akiba fails to disclose an arrangement wherein a first orientation is preserved for subsequent uses until changed by a user. Therefore, Akiba cannot anticipate independent claim 20.

Applicants believe that all of the claims pending in this patent application are allowable and that all other issues raised by the examiner have been rectified. Therefore, applicants respectfully request the examiner to reconsider the rejections and to grant an early allowance. If any questions or issues

remain to be resolved, the examiner is requested to contact the applicants' attorney at the telephone number listed below.

Respectfully submitted,

DAHL & OSTERLOTH, L.L.P.



Bruce E. Dahl, Esq.
Attorney for Applicants
PTO Registration No. 33,670
555 17th Street, Suite 3405
Denver, CO 80202
(303) 291-3200

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